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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WILLIAMS, JEFFERY L

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,396

Applicant(s)

MCCANN ET AL.

Examiner

Jeffery Williams

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the communication filed on 6/27/06.

All objections and rejections not set forth below have been withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/27/06 has been entered.

Election/Restrictions

Newly submitted claims 16 – 20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 – 15, 21, drawn to a system and method of a user to employ a mobile device, PIN, and cellular mobile account for accessing a visiting W-LAN, classified in class 713, subclass 150.

II. Claims 16 – 20, drawn to a method of establishing a W-LAN account for a user and billing the W-LAN account so as to enable a user to employ a PIN for accessing a W-LAN, classified in class 726, subclass 17 and class 705, subclass 30.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as it creates and bills W-LAN accounts so a user with a PIN can access a network.

Subcombination I has separate utility such as a user utilizes a browser, computing device, and mobile phone and mobile cellular account for accessing access a network.

See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a

claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16 – 20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1 **Claims 1 – 9, 11 – 15, and 21 are rejected under 35 U.S.C. 103(a) as being**
2 **unpatentable over Rai et al. (Rai), “Registration Scheme for Network”, U.S. Patent**
3 **6,675,208 in view of Turunen, “Mobile Internet Access”, U.S. Patent 6,477,644 in**
4 **view of Prins, “Authentication System”, Dutch Patent 1007409.**

5
6 Regarding claim 1, Rai discloses *a user requesting visiting access to the first W-*
7 *LAN (Rai, fig. 3). Rai discloses the user having a portable computing device and a*
8 *registration with a second W-LAN operator that administers a home authentication,*
9 *authorization and accounting (HAAA) server (Rai, fig. 3:60, 72). While Rai describes his*
10 mobile access system with the term PCS as opposed to cellular, the examiner points
11 that those of ordinary skill in the art recognize the PCS band as “cellular” (see evidence
12 – Soliman [par. 75]; Antonio et al. [par. 4]; Cheng et al. [1:15-29]). Rai thus discloses a
13 *valid cellular mobile account (Rai, 3:5-15; 6:32-39). Rai does not mention that the*
14 portable computing device [used to access and communicate data over the network]
15 has a browser, however, the examiner notes that it was well known in the art for
16 portable communication devices to utilize browsers facilitating data communication (for
17 exemplary evidence, see Hansen et al., “Accessing a Server Computer Connected to a
18 Wireless Communication Network”, UK Patent Publication, 2 342 816: 1:9-13; 7:29-8:2).

19 Rai discloses a modem for communicating data within the wireless network. Rai
20 does not disclose a mobile telephone for communicating data within the wireless
21 network.

1 However, the examiner points out that it was well known in the art to utilize
2 mobile telephones as modems to communicate data within a wireless network. Similar
3 to Rai, Turunen discloses a mobile access system. Turunen discloses that those of
4 ordinary skill in the art employ mobile telephones in cooperation with a portable
5 computing device for data communication (Turunen, 1:36-49).

6 It would have been obvious employ a mobile telephone as taught by Turunen as
7 the data communication device within the mobile access system of Rai. This would
8 have been obvious because one of ordinary skill in the art would have been motivated
9 to utilize established methods in the art and by benefits of versatility (i.e. a user could
10 employ devices that would allow voice communication as well as data communication).

11 Furthermore, the combination of Rai and Turunen discloses - *conveys to the*
12 *VAAA server, by user intervention, identity information sufficient to enable said VAAA*
13 *server to communicate with said HAAA server so as to authenticate the proposed*
14 *connection* (Rai, 8:45-47; 9:21-26).

15 The combination of Rai and Turunen discloses users who employ portable
16 devices to register with a foreign network and to access wireless services (i.e. internet)
17 (Rai, fig. 3). The combination discloses that before such access can be granted the
18 user must be authenticated, such as by using a password ("PIN") supplied by the user,
19 and the combination discloses that the user's HAAA server controls the authentication
20 of the user (Rai, fig. 14, "PPP Authentication" "PAP"). The combination, however, does
21 not disclose how a user desiring such access would acquire the necessary

1 password/PIN for purposes of satisfying the authentication requirements of the HAAA
2 server.

3 In a similar endeavor, Prins discloses a method for enabling a user to employ a
4 portable computing device and mobile telephone to access network services (Prins, fig.
5 1). Particularly, Prins focuses on the method for providing users with the necessary PIN
6 for authentication to a service providing network. Prins discloses that after a user
7 establishes a connection to a network (Prins, 3:18-20), the user is provided with a
8 PIN/password in the form of an SMS message to the user's personal communication
9 device (Prins, 4:5-8) via a secure link [i.e. data encoding as in GSM or VPN] (Prins, 5:1-
10 7; 6:3-7).

11 It would have been obvious to one of ordinary skill in the art to employ the secure
12 PIN provisioning methods of Prins within the HAAA server of Rai and Turunen. This
13 would have been obvious because one of ordinary skill in the art would have been
14 motivated by the need to provide a user with an authentication PIN and by the teachings
15 of Prins, wherein this method of PIN provisioning features increased security (Prins, 2:7-
16 11; 18-21).

17 The combination of Rai, Turunen, and Prins discloses *the cost of such access*
18 *being billed to the user's cellular mobile account and the requested access being*
19 *achieved via the user's browser* (Ria, fig. 3:60; 3:5-15; 6:32-39).

20
21 Regarding claim 2 the combination of Rai, Turunen, and Prins discloses:

1 *wherein the transfer of the PIN to the browser is effected manually by the user (Prins,*
2 *6:8-14).*

3
4 Regarding claim 3 the combination of Rai, Turunen, and Prins discloses:
5 *wherein the portable computing device is coupled to the mobile telephone and*
6 *the transfer of the PIN to the browser is effected automatically by means including*
7 *software supported by the portable computing device (Prins, 6:8-14).*

8
9 Regarding claim 4 the combination of Rai, Turunen, and Prins discloses:
10 *wherein the PIN issued by the HAAA is encoded and forwarded to the user's*
11 *mobile telephone by means of a short message service centre (Prins, 4:5-7).*

12
13 Regarding claim 5 the combination of Rai, Turunen, and Prins discloses:
14 *wherein the user employs the browser to convey said identity information, via the first*
15 *W-LAN, to the VAAA (Rai, fig. 1:60,62,70; fig. 14).*

16
17 Regarding claim 6 the combination of Rai, Turunen, and Prins discloses:
18 *wherein the PIN is combined with masking information (Rai, 23:48-51; Prins, 5:1-7; 6:3-*
19 *7).*

20

1 Regarding claim 7, the combination of Rai, Turunen, and Prins is silent regarding
2 a random derivation of masking information. However, the examiner points out that it is
3 well known in the art of encryption to employ random elements for purpose of security.
4

5 Regarding claim 8, the combination of Rai, Turunen, and Prins discloses:
6 *wherein the user calls the VAAA on the mobile telephone* (Rai, fig. 1:2,4; fig. 14;
7 Turunen, 1:36-40). The mobile user communicates with the FA through a mobile
8 telephone.
9

10 Regarding claim 9, the combination of Rai, Turunen, and Prins discloses:
11 *wherein the telephone call from said user is routed to the HAAA through a premium rate*
12 *call unit* (Rai, 1:62-67; 5:31-39; 6:32-39).
13

14 Regarding claim 11, it is a method claim corresponding to the system of claim 1,
15 and it is rejected, at least, for the same reasons. Furthermore, the combination of Rai,
16 Turunen, and Prins discloses that the request includes *identity information of a home*
17 *authentication, authorization and accounting server* (Rai, 8:45-47; 9:21-26).
18

19 Regarding claims 12 – 15 and 21, they are rejected, at least, for the same
20 reasons as the above claims. Furthermore, the combination of Rai, Turunen, and Prins
21 discloses a *wireless link* and that *the transfer of the PIN is effected automatically via a*
22 *wireless link* (Ria, 5:56-65; Prins, 6:8-14).

Response to Arguments

Applicant's arguments with respect to claims 1 – 9, 11 – 15, and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

See Notice of References Cited

A shortened statutory period for reply is set to expire **3** months (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2137

1 Information regarding the status of an application may be obtained from the
2 Patent Application Information Retrieval (PAIR) system. Status information for
3 published applications may be obtained from either Private PAIR or Public PAIR.
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6 you have questions on access to the Private PAIR system, contact the Electronic
7 Business Center (EBC) at 866-217-9197 (toll-free).

8
9
10 J. Williams
11 AU: 2137

JW


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SUPERVISORY PATENT EXAMINER